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In re Application of  
AEBI et al.  
Application No.: 10/538,542  
PCT No.: PCT/CH02/000706  
Int. Filing: 17 December 2002  
Priority Date: None  
Attorney Docket No.: LUS-16099  
For: INTERVERTEBRAL IMPLANT  
COMPRISING JOINT PARTS THAT  
ARE MOUNTED TO FORM A  
UNIVERSAL JOINT

DECISION ON PETITION

This decision is in response to applicants' "Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b)" and "Petition under 37 CFR 1.47(a)" filed 22 September 2006 in the above-captioned application. The requisite \$1500 petition fee for the filing of a petition under 37 CFR 1.137(b) and the requisite \$200 petition fee have been submitted. The above captioned national stage application became abandoned for failure to submit an oath or declaration within the time period set forth in the Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) mailed 25 November 2005.

**BACKGROUND**

On 17 December 2002, applicants filed international application PCT/CH02/000706, which claimed no priority date. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 01 July 2004. Pursuant to 37 CFR 1.495, the period for paying the basic national fee in the United States expired 30 months from the international filing date, 17 June 2005.

On 10 June 2005, applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a translation of the international application; an application data sheet; and a preliminary amendment.

On 25 November 2005, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

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On 04 August 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Abandonment indicating that the application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 25 November 2005 within the time period set therein.

On 22 September 2006, applicants filed a "Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b)" and a Petition under 37 CFR 1.47(a).

### DISCUSSION

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional delay must be accompanied by: (1) the required reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c). Applicants have satisfied Items (2)-(4).

In order to comply with the proper response requirement of item (1) above for revival under 37 CFR 1.137(b), applicants submitted the present Petition Under 37 CFR 1.47(a). Under the present circumstances, in order for the response requirement, item (1) above, to be satisfied, the petition to accept the application without the signature of Max Aebi must be grantable.

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Items (1) and (4) have been satisfied.

Regarding item (2) above, petitioner states that Max Aebi has refused to sign the application. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient.

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When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner states that Max Aebi has refused to sign the application. A review of the present petition and the accompanying papers reveals that applicants have not satisfied item (2) above, in that the applicants have not shown that a bona fide attempt was made to present the application papers to Max Aebi. The statement of Carrie A. McPherson states that a copy of the application papers were sent (via electronic mail) to Max Aebi on August 22, 2006. A copy of the electronic mail has been provided. However, petitioner fails to include evidence to demonstrate that the materials were actually received by the nonsigning inventor. (The "Delivery Status Notification" only confirms delivery, not receipt.) Where the Office is being asked to accept the silence of the nonsigning inventor as evidence of a refusal to sign, petitioner must provide some evidence that the application materials have been received by the nonsigning applicant.

Regarding item (3) above, a clear statement of the last known address of the nonsigning inventor has not been provided. In situations where an inventor does not execute the oath or declaration, the inventor's most recent home address must be given to enable the Office to communicate directly with the inventor as necessary. (See MPEP §605.03)

For the above reasons, it would not be appropriate to accept this application without the signature of Max Aebi at this time and the application remains abandoned.

### CONCLUSION

The petition under 37 CFR 1.137(b) is DISMISSED without prejudice and the application remains ABANDONED.

The petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration

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request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a) and 37 CFR 1.137(b)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to:  
Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box  
1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the  
attention of the Office of PCT Legal Administration.

A handwritten signature in black ink, appearing to read "Anthony Smith", with a stylized flourish at the end.

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